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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

BAXTER, G

ART UNIT PAPER NUMBER

3632

13

DATE MAILED: 07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/405,628

Applicant(s)
Odd N. Oddsen Jr.

Examiner
Gwendolyn Baxter

Art Unit
3632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 16, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 and 89-107 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74 and 89-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 24, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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Art Unit: 3632

DETAILED ACTION

This is the second office action for serial number 09/405,628, Arm Apparatus for Mounting Electronic Devices, filed on September 24, 1999.

Election/Restrictions

Claims 75-88 and 108-171 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made without traverse in paper no. 11 and these claims have been canceled per applicant's request.

Priority

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged and has been granted.

Information Disclosure Statement

The information disclosure statements filed November 30, 2000, January 30, 2001 and April 16, 2001 have been placed in the application file, and the information referred to therein has been considered as to the merits.

Art Unit: 3632

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the computer monitor, television and flat screen device, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The reference numeral "168" on page 18, line 7, should read --170--.

Specification

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet not *exceeding 150 words*. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3632

Claims 8-14, 18, 19 and 58-74 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, line 7, the pronoun "its" should be replaced with the proper noun to avoid any ambiguity, thus distinctly claiming and particularly pointing out the subject matter. Similar problem occurs in claim 10.

In claim 58, line 1, "said second end coupling" lacks proper antecedent basis. Similar problem occurs in claim 67, 69, and 72.

In claim 59, line 1, "said second end female coupling" lacks proper antecedent basis.

In claim 61, line 1, "said means for connecting" lacks proper antecedent basis.

In claim 62, line 1, "said first end coupling" lacks proper antecedent basis. Similar problem occurs in claims 69 and 72

In claim 64, line 2, "said first end female coupling" lacks proper antecedent basis.

In claim 71, lines 1 and 2, "the first axial centerline" and "the second axial centerline" lack proper antecedent basis. Similar problem occurs in claim 73.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

Art Unit: 3632

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-74 and 89-107 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 and 92-118 of copending Application No. 09/406,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because after examination of the instant claims clearly indicates that the subject matter thereof is fully disclosed by the claims of said patent and/or that portion of the patent disclosure which provides support for such claims. Therefore, it is self evident that the instant claims are nothing more than obvious variations of the inventions disclosed and claimed in said patent and cannot properly issue in the absence of a terminal disclosure. Furthermore, it is also clear that the inventor could have included the instant claims in said patent and that if the instant application were to issue without a terminal disclaimer

Art Unit: 3632

protection of the previously patent inventions would be improperly extended until the expiration of the instant claims since the utilization of such inventions would infringe the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 8-11, 20-21, 31, 32, 34, 36, 37, 57, 58, 61, 62, 65-67 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by applicant's prior art of Figures 1-7, hereinafter referred to as prior art. The prior art discloses an extension arm comprising a forearm extension (10), a first end cap (12), a second end cap (18), an upper channel (14), a lower channel (16) and a gas spring (28). The first and second end caps include a first and second end cap body (not numbered) and a first and second end cap shaft (22, 92). The upper channel having a first and second rollers (66) and the lower channel having a third and fourth rollers (84). The second end (34) of the first end cap body has a hole (36) therein. Furthermore, the first end cap includes a clevis (48) and rod (38). The first end of the first end cap includes a shaped opening (42) for receiving a shaped key. The rod includes a shoulder (between reference numerals 44 and 42).

Art Unit: 3632

The upper channel includes a threaded hole (not numbered) for receiving a ball stud (72) which is connected to the gas spring (28). Each end cap is pivotably attached to each channel by the insertion of a pin (24). The interior area of each end cap forms a trough.

Claim Rejections - 35 USC § 103

Claims 5, 22, 89-93, and 98-103 are rejected under 35 U.S.C. § 103 as being unpatentable over applicant's prior art of Figures 1-7, hereinafter referred to as prior art. The prior art disclose all the limitations of the base claim excluding the device being integrally formed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the device integral, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leporati 3,409,261; Souder 4,447,031; Smeenge 4,616,798; and Soberalski 4,706,919 teach extension arms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is (703) 308-0702. The

Art Unit: 3632

examiner can normally be reached Monday-Friday from 7:00 A.M. to 3:30 P.M. Eastern Time Zone.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703) 305-3597.


Gwendolyn Baxter
June 30, 2001


ANITA KING
PRIMARY EXAMINER